

Van Leeuwen & Van Leeuwen
Attorneys at Law
6123 Pebble Garden Court
Austin, Texas 78739
Phone # 512-301-6738
FAX # 512-301-6742

RECEIVED
CENTRAL FAX CENTER
MAR 04 2005

DATE: March 4, 2005

Number of Pages to Follow (including this cover sheet) 44

SEND TO: United States Patent Office

Examiner: **Pesin, Boris M.**

Group Art Unit: **2174**

Tel No: (571) 272-4070

Fax #: (703) 872-9306

FROM: Joseph T. Van Leeuwen
Van Leeuwen & Van Leeuwen
Registered Patent Attorneys
6123 Pebble Garden Court
Austin, Texas 78739
Tel No: 512-301-6738
Fax No. 512-301-6742

THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED, AND MAY CONTAIN INFORMATION THAT IS PRIVILEGED, CONFIDENTIAL AND EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAW. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS ABOVE VIA THE U.S. POSTAL SERVICE. THANK YOU.

Docket No. RSW920010012US1

Serial No. 09/845,537

Atty: GRW / JVL

Applicant: Molander

☒ Transmittal Letter (2 copies)

☐ Amendment (☐ pages)

☐ Amendment AF

☐ Ext. of Time

☐ IDS Statement

☐ Other

☒ Certificate of Facsimile (incl. w/Appeal Brief)

☐ Notice of Appeal

☒ Appeal Brief (41 pages)

☐ Reply Brief

☐ Change of Address

Deposit Acct. No. 09-0461

Fees: Amendment ☐ Notice of Appeal ☐ Appeal Brief \$500.00 Other ☐

File: **IBM-R105**

*complete
43 pages*

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

IBM DOCKET NO. RSW920010012US1

DATE: March 4, 2005

Application Serial No.: 09/845,537

Sir:

Assignee Name: International Business Machines Corporation

Assignee Residence: Armonk, New York

Transmitted herewith for filing is the Patent Application of:

Inventors: Molander

For: System and Method for Multifunction Menu Objects

Enclosed are:

☒ Appeal Brief [\$500].

Any additional filing fees have been calculated as shown below:

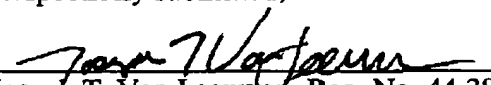
For	Number Filed	Number Added	Number Extra	Rate	Additional Fee
Total Claims		0	0	x \$50	\$ 0.00
Indep. Claims		0	0	x \$200	\$ 0.00

Total: \$ 0.00

☒ Please charge my Deposit Account No. 09-0461 in the amount of \$500.00. A duplicate copy of this sheet is enclosed.☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 09-0461. A duplicate copy of this sheet is enclosed.☒ Any additional filing fees required under 37 CFR Sect. 1.16.☒ Any patent application processing fees under 37 CFR Sect. 1.17.☒ No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

Respectfully submitted,

By


Joseph T. Van Leeuwen, Reg. No. 44,383
Van Leeuwen & Van Leeuwen
Attorneys for Applicant
Telephone: (512) 301-6738
Facsimile: (512) 301-6742

Atty Ref. No. IBM-R105

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

IBM DOCKET NO. RSW920010012US1
DATE: March 4, 2005

Application Serial No.: 09/845,537

Sir:

Assignee Name: International Business Machines Corporation
Assignee Residence: Armonk, New York

Transmitted herewith for filing is the Patent Application of:

Inventors: Molander

For: System and Method for Multifunction Menu Objects

Enclosed are:

☒ Appeal Brief [\$500].

Any additional filing fees have been calculated as shown below:

For	Number Filed	Number Added	Number Extra	Rate	Additional Fee
Total Claims		0	0	x \$50	\$ 0.00
Indep. Claims		0	0	x \$200	\$ 0.00

Total: \$ 0.00

☒ Please charge my Deposit Account No. 09-0461 in the amount of \$500.00. A duplicate copy of this sheet is enclosed.

☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 09-0461. A duplicate copy of this sheet is enclosed.

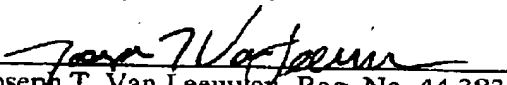
☒ Any additional filing fees required under 37 CFR Sect. 1.16.

☒ Any patent application processing fees under 37 CFR Sect. 1.17.

☒ No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

Respectfully submitted,

By


Joseph T. Van Leeuwen, Reg. No. 44,383
Van Leeuwen & Van Leeuwen
Attorneys for Applicant
Telephone: (512) 301-6738
Facsimile: (512) 301-6742

Atty Ref. No. IBM-R105

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Molander

Serial No.: 09/845,537

Filed: April 30, 2001

Title: System and Method for
Multifunction Menu Objects

§ Group Art Unit: 2174

§

§ Examiner: Golinkoff, Jordan

§

§ Attorney Docket No.

§ RSW920010012US1

§

§ IBM Corporation

§ Software Group IP Law -- T81/503

§ 3039 Cornwallis Road

§ Research Triangle Park, NC 27709

RECEIVED
CENTRAL FAX CENTER

MAR 04 2005

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Certificate of Mailing or Transmission

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.


Joseph T. Van Leeuwen3/4/05
Date**APPELLANTS' BRIEF (37 CFR § 41.37)**

Sir:

A. INTRODUCTORY COMMENTS

This brief is filed in support of the previously filed Notice of Appeal, filed in this case on January 6, 2005, which appealed from the Advisory Action of the Examiner dated November 23, 2004 finally rejecting claims 1-5, 7-17, and 19-26. Please charge the required fee under 37 CFR § 41.20(b)(2) to IBM Corporation Deposit Account No. 09-0461.

The three-month deadline for filing this Appeal Brief is March 6, 2005, therefore, no extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

Docket No. RSW920010012US1

Page 1 of 41
Molander - 09/845,537

Atty Ref. No. IBM-R105

PATENT

B. REAL PARTY IN INTEREST

The real party in interest in this appeal is International Business Machines Corporation, which is the assignee of the entire right, title, and interest in the above-identified patent application.

C. RELATED APPEALS AND INTERFERENCES

With respect to other prior or pending appeals, interferences, or judicial proceedings that are related to, will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such prior or pending appeals, interferences, or judicial proceeding known to Appellants, Appellants' legal representative, or assignee.

D. STATUS OF CLAIMS*1. Total number of claims in application*

There are 24 claims pending. Nine claims are independent claims (1, 9, 13, 21, 22, 23, 24, 25, and 26), and the remaining claims are dependent claims.

2. Status of all claims in application

- Claims canceled: 6 and 18.
- Claims withdrawn from consideration but not canceled: None.
- Claims pending: 1-5, 7-17, and 19-26.
- Claims allowed: None.
- Claims rejected: 1-5, 7-17, and 19-26.

3. Claims on appeal

The claims on appeal are: 1-5, 7-17, and 19-26.

PATENT

E. STATUS OF AMENDMENTS

All amendments have been entered in this case. No amendments have been made to the claims after the Final Office Action.

F. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants provide a concise summary of the claimed subject matter as follows. Claims 1, 9, 13, 21, 22, 23, 24, 25, and 26 are independent claims. Note that claims 1, 21, and 22 are method claims, claims 9, 23, and 24 are information handling system claims, and claims 13, 25, and 26 are computer program product claims. Independent claims 13, 25, and 26 include means plus function limitations that correspond to the method steps set forth in independent claims 1, 21, and 22, respectively. An information handling system capable of implementing Appellants' invention, as claimed in independent claims 9, 23, and 24 is shown in Figure 7, and described in Appellants' specification on page 17, line 17 – page 18 line 26. Support for independent computer program product claims 13, 25, and 26 are described in Appellants' specification on page 19, lines 1 – 18,. In addition, support for each of the method steps and means plus function limitations of the independent claims are discussed below. The specific citations to Appellants' Figures and Specification are meant to be exemplary in nature, and do not limit the scope of the claims. In particular, the citations below do not limit the scope of equivalents as provided under 35 U.S.C. § 112, sixth paragraph.

In one aspect of Appellants' invention, claims 1, 9, and 13 claim a method / information handling system / computer program product for providing secondary functions from a menu item graphical control including a plurality of graphical components with the menu item graphical control, each of the graphical components corresponding to a different programmed function (see e.g., Figure 1, elements 100, 125, 130, and 140; specification page 8, line 8 through page 9, line 24) , wherein the menu item graphical control includes a default area in addition to the plurality of graphical components (see e.g., Figure 2, elements 200 and 240 default areas and 210-230 and 250-270 graphical components; specification page 9, line 25 through page 10, line 30); displaying the menu item graphical control with the included graphical components and the default area (see e.g., Figure 2, elements 200 and 240; specification page 9, line 25 through page 10, line 30) , wherein each of the graphical components are displayed in a position horizontal to

PATENT

the default area(see e.g., Figure 2, elements 200 and 240 default areas and 210-230 and 250-270 graphical components; specification page 9, line 25 through page 10, line 30); receiving a selection from a user corresponding to the menu item graphical control (see e.g., Figure 6, element 610; specification page 15, line 18 through page 17, line 16) ; invoking a default function in response to the selection corresponding to the default area of the menu item graphical control (see e.g., Figure 6, elements 640 to 645; specification page 15, line 18 through page 17, line 16); and in response to the selection corresponding to one of the graphical components, invoking the programmed function corresponding the selected graphical component (see e.g., Figure 6, elements 655 to 690; specification page 15, line 18 through page 17, line 16) .

In another aspect of Appellants' invention, claims 21, 23, 25 claim a method / information handling system / computer program product for providing secondary functions from a menu item graphical control by configuring one or more secondary functions to include in a sub-menu (see e.g., Figure 5, elements 535 to 590; specification page 14, line 1 through page 15, line 17); modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu, wherein the menu item graphical control further includes one or more graphical components corresponding to one or more programmed functions (see e.g., Figure 5, element 580; specification page 14, line 1 through page 15, line 17); and displaying the sub-menu in response to a user selecting the sub-menu graphical component (see e.g., Figure 6, elements 680 to 690; specification page 15, line 18 through page 17, line 16).

In yet another aspect of Appellants' invention, claims 22, 24, 26 claim a method / information handling system / computer program product for providing secondary functions from a menu item graphical control by configuring a plurality of programmed functions using a configuration tool (see e.g., Figure 4, element 400; specification page 12, line 15 through page 13, line 30); identifying a plurality of graphical components for each of the programmed functions (see e.g., Figure 4, elements 430 and 450; specification page 12, line 15 through page 13, line 30 and Figure 5, elements 535 to 590; specification page 14, line 1 through page 15, line 17); modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions (see e.g., Figure 4, element 450; specification page 12, line 15 through page 13, line 30 and Figure 5, element 580; specification page 14, line 1 through page 15, line 17); displaying the menu item graphical control with the

PATENT

included graphical components (see e.g., Figure 6, element 605; specification page 15, line 18 through page 17, line 16 and Figure 2, elements 210-230 and 250-270; specification page 9, line 25 through page 10, line 30) ; receiving a selection from a user corresponding to one of the graphical components (see e.g., Figure 6, elements 655-670; specification page 15, line 18 through page 17, line 16); and invoking the programmed function corresponding the selected graphical component (see e.g., Figure 2, elements 215, 225, 235, 255, 265, and 275; specification page 9, line 25 through page 10, line 30 and Figure 6, element 665; specification page 15, line 18 through page 17, line 16).

Support for each of Appellants' means plus function limitations set forth in dependent claims is provided below. Note that general support for an information handling system and computer program product is discussed above. The specific citations to Appellant's Figures and Specification are meant to be exemplary in nature, and do not limit the scope of the claims, as provided under 35 U.S.C. § 112, sixth paragraph.

Claim 14 includes the following means plus function limitation:

means for displaying a sub-menu of selectable programmed functions in response to the user selecting a sub-menu graphical component (see e.g., Figure 1, elements 125, 130, 145, and 150; specification page 8, line 8 through page 9, line 24, Figure 2, elements 230, 235, 280, and 285; specification page 9, line 25 through page 10, line 30, and Figure 6, elements 680 - 690; specification page 15, line 18 through page 17, line 16)).

Claim 16 includes the following means plus function limitations:

means for configuring the plurality of programmed functions using a configuration tool (see e.g., Figure 4, specification page 12, line 15 through page 13, line 30 and Figure 5, specification page 14, line 1 through page 15, line 17);

means for modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions (see e.g., Figure 5, elements 575 and 580; specification page 14, line 1 through page 15, line 17); and

means for saving the configured plurality of programmed functions and the modified menu item graphical control (see e.g., Figure 5, element 580; specification page 14, line 1 through page 15, line 17) .

PATENT

Claim 17 includes the following means plus function limitations:

means for configuring a plurality of secondary functions to include in a sub-menu (see e.g., Figure 4, specification page 12, line 15 through page 13, line 30 and Figure 5, specification page 14, line 1 through page 15, line 17);

means for modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu (see e.g., Figure 5, elements 540 - 555; specification page 14, line 1 through page 15, line 17); and

means for saving the plurality of secondary functions and the modified menu item (see e.g., Figure 5, element 555; specification page 14, line 1 through page 15, line 17).

G. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-5, 7-17, and 19-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by a Google Toolbar, with an alleged publication date of February 2, 2001.

H. ARGUMENTS – APPELLANTS' CLAIMS ARE NOT OBVIOUS, AND ARE THEREFORE PATENTABLE, OVER THE ART OF RECORD**Appellant's Claims Are Not Anticipated by the Google Toolbar Reference.**

Appellant respectfully submits that the Examiner has failed to satisfy the burden for rejecting Appellant's claimed invention under 35 U.S.C. § 102. In particular, Appellant avers that the Google Toolbar reference simply does not teach each and every element of Appellant's claimed invention. MPEP § 2131 states:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in

PATENT

the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

Appellant claims a system, method, and program product for providing multiple user-selectable functions from an individual menu item. A menu item can be configured to contain an application portion (which launches the corresponding application), a sub-menu portion (which launches a sub-menu), and/or icons corresponding to frequently used functions.

The Google Toolbar does not disclose multiple user-selectable functions from an individual menu item, as claimed in each of Appellant's independent claims. As shown in the web pages cited in the Final Office Action, the Google Toolbar can be installed so that it is attached to a user's Internet Explorer browser bar. In effect, the Google Toolbar becomes another toolbar that can be used from another web page. The Google Toolbar is therefore not a "menu item graphical control" as taught and claimed by Appellant in each of the independent claims. Accordingly, the Google Toolbar reference does not teach each and every element of Appellant's claimed invention as required under MPEP § 2131 in order to reject Appellant's claims under 35 U.S.C. § 102(e).

The Google Toolbar does show a menu being launched from the Google Toolbar (see the section titled "Google Toolbar Drop Down Menu"). However, each of the menu items in the drop down menu, e.g. "Google's Home Page," "Web Directory," "Usenet Groups," etc., contains a single menu item. A user can perform one, and only one, function per menu item. None of the menu items shows a "menu item graphical control" containing "a plurality of graphical components," where each of the graphical components corresponds to a different programmed function, as taught and claimed by Appellant.

PATENT

Appellant respectfully submits that the Google Toolbar reference, cited by the Examiner in the Final Office Action, simply does not teach each and every element of Appellant's claimed invention. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejection of Appellant's pending claims under 35 U.S.C. § 102(e) and allow Appellant's claims to issue.

Docket No. RSW920010012US1

Page 8 of 41
Molander - 09/845,537

Atty Ref. No. IBM-R105

PATENT

The Google Toolbar Is NOT Prior Art to Appellant's Claimed Invention

Notwithstanding the fact that the Google Toolbar reference cited by the Examiner does not teach each and every element of Appellant's claimed invention, as set forth above, Appellant further submits that the Google Toolbar reference is not prior art to Appellant's claimed invention. In Appellant's Response to the Final Office Action, Appellant's submitted a timely declaration under 37 C.F.R. § 1.131 properly swearing behind the Google Toolbar reference.

In Appellant's Response to the Final Office Action, Appellant asserted that Appellant conceived of the claimed invention prior to the publication or disclosure of Google Toolbar, and that Appellant showed diligence from Appellant's conception date to the filing date of Appellant's application. A declaration, pursuant to 37 C.F.R. § 1.131, was duly executed by Appellant Mark E. Molander and included with Appellant's Response to the Final Office Action. Mr. Molander declared that Appellant's claimed invention was conceived of prior to February 2, 2001, and that diligence was shown in filing the application on April 30, 2001. Exhibit "A" to Mr. Molander's declaration was a copy of the IBM invention disclosure that disclosed Appellant's invention. The Disclosure was submitted to the IBM Intellectual Property Law Department in Raleigh, North Carolina prior to February 2, 2001. Mr. Molander's declaration under 37 C.F.R. § 1.131, therefore, removed the Google Toolbar reference from consideration as prior art. Because, for the aforesaid reasons, the Google Toolbar publication is not prior art with respect to Appellant's claimed invention, Appellant respectfully requests the Board to reverse the Examiner's rejection of claims 1-5, 7-17, and 19-26 under 35 U.S.C. § 102(e).

In the Advisory Action, the Examiner indicated that Appellant's declaration was considered but did not place the application in condition for allowance (the Examiner properly checked the box in paragraph 5 of the Advisory Action for consideration of an "affidavit"). However, the continuation sheet of the Advisory Action stated that Appellant's declaration "does NOT place the application in condition for allowance because: The affidavit raises new issues that would require further consideration and search." Appellant notes that under current MPEP rules the Examiner should have fully searched Appellant's claimed invention when preparing the Final Office Action. MPEP § 904.03 provides that the Examiner is to make a "careful and

PATENT

comprehensive" search of Appellant's claimed invention when preparing the Office Action. MPEP § 904.03 states as follows (emphasis added):

904.03 Conducting the Search

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment. Applicants can facilitate a complete search by including, at the time of filing, claims varying from the broadest to which they believe they are entitled to the most detailed that they would be willing to accept.

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious.

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure to avoid the citation of an unnecessary number. The examiner is not called upon to cite all references that may be available, but only the "best." (37 CFR 1.104(c).) Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided. The examiner must fully consider all the prior art references cited in the application, including those cited by the applicant in a properly submitted Information Disclosure Statement.

The best reference should always be the one used. Sometimes the best reference will have a publication date less than a year prior to the application filing date, hence it will be open to being overcome under 37 CFR 1.131. In these cases, if a second reference exists which cannot be so overcome and which, though inferior, is an adequate basis for rejection, the claims should be additionally rejected thereon.

In all references considered, including nonpatent, foreign patents, and domestic patents, the examiner should study the specification or description sufficiently to determine the full value of the reference disclosure relative to the claimed or claimable subject matter.

PATENT

Appellant respectfully submits that the Examiner admits that he did not conduct a full and complete search as required by MPEP § 904.03 by stating that presentation of Appellant's Rule 1.131 declaration would require "further consideration and search." In particular, MPEP § 904.03 specifically contemplates the situation presented in this Appeal – namely, the Examiner chose a "best" reference that was less than a year older than Appellant's filing date without having a second reference available.

In the Advisory Action, the Examiner states that Appellant's presentation of the declaration under 37 C.F.R. § 1.131 removing the Google Toolbar reference requires "further consideration and search." Appellant respectfully disagrees. Further searching is not required because the Examiner should have already fully searched Appellant's claimed invention pursuant to MPEP § 904.03. Because the "best" reference found by the Examiner was a § 102(e) reference, the Examiner, pursuant to § 904.03, should have determined if a second reference exists which cannot be so overcome and which, though inferior, is an adequate basis for rejection, the claims should be additionally rejected thereon. Appellant further notes that "consideration" of Appellant's declaration under 37 C.F.R. § 1.131 has already been admitted by the Examiner (the Advisory Action noted that the declaration had been considered). Finally, Appellant notes that Appellant's submission of the declaration under 37 C.F.R. § 1.131 was timely presented. The Examiner did not cite the Google Toolbar reference in any preceding Office Action. Therefore, Appellant's first opportunity to swear behind the reference was in the Response to the Final Office Action. Accordingly, Appellant's declaration under 37 C.F.R. § 1.131 was timely presented. MPEP § 715.09(C)(1) states as follows:

715.09 Seasonable Presentation

Affidavits or declarations under 37 CFR 1.131 must be timely presented in order to be admitted. Affidavits and declarations submitted under 37 CFR 1.131 and other evidence traversing rejections are considered timely if submitted:

...

(C) after final rejection and submitted

(1) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection

...

PATENT

Review of an examiner's refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); *Ex parte Hale*, 49 USPQ 209 (Bd. App. 1941). See MPEP § 715.08 regarding review of questions of propriety of 37 CFR 1.131 affidavits and declarations.

Appellant notes that the Examiner did not refuse to enter Appellant's declaration under 37 C.F.R. § 1.131. Instead, it appears that the Examiner was unable to find a secondary reference that taught Appellant's claimed invention when preparing the Final Office Action. Appellant respectfully submits that the Examiner should have cited a secondary reference if one existed. Consequently, the Examiner should have responded with a Notice of Allowance of Appellant's remaining claims when presented with Appellant's declaration under Rule 1.131 as the Examiner was unable to cite any prior art that teaches or suggests Appellant's claimed invention.

To advance the goal of compact prosecution, the Examiner had a duty to find secondary references, if available, especially in light of the fact that the art cited by the Examiner was within one year of Appellant's filing date and thus subject to being removed with a proper declaration or affidavit under Rule 1.131. MPEP § 903.04 specifically contemplates and discusses this situation. The Google Toolbar reference is not prior art to Appellant's claimed invention and the Examiner did not cite any other secondary references found during the Examiner's search that allegedly teach or suggest Appellant's claimed invention. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejection of Appellant's pending claims under 35 U.S.C. § 102(e) and allow Appellant's claims to issue.


Conclusion

For the foregoing reasons, Appellant submits that claims 1-5, 7-17, and 19-26 are allowable over the Google Toolbar reference. Moreover, Appellant submits that the Google Toolbar reference is not prior art to Appellant's claimed invention. Accordingly, Appellant respectfully requests that the Examiner's claim rejections be reversed and claims 1-5, 7-17, and 19-26 be allowed.

PATENT

Respectfully submitted,

By



Joseph T. Van Leeuwen, Reg. No. 44,383

Van Leeuwen & Van Leeuwen

Attorneys for Appellants

Telephone: (512) 301-6738

Facsimile: (512) 301-6742

Docket No. RSW920010012US1

Page 13 of 41
Molander - 09/845,537

Atty Ref. No. IBM-R105

PATENT

I. APPENDIX - CLAIMS INVOLVED IN THIS APPEAL

1. A method of providing secondary functions from a menu item graphical control, said method comprising:
including a plurality of graphical components with the menu item graphical control, each of the graphical components corresponding to a different programmed function, wherein the menu item graphical control includes a default area in addition to the plurality of graphical components;
displaying the menu item graphical control with the included graphical components and the default area, wherein each of the graphical components are displayed in a position horizontal to the default area;
receiving a selection from a user corresponding to the menu item graphical control;
invoking a default function in response to the selection corresponding to the default area of the menu item graphical control; and
in response to the selection corresponding to one of the graphical components, invoking the programmed function corresponding the selected graphical component.
2. The method as described in claim 1 further comprising:
displaying a sub-menu of selectable programmed functions in response to the user selecting a sub-menu graphical component.
3. The method as described in claim 1 wherein at least one of the graphical components includes a graphical icon that is displayed on the menu item graphical control.

PATENT

4. The method as described in claim 1 further comprising:
configuring the plurality of programmed functions using a configuration tool;
modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions; and
saving the configured plurality of programmed functions and the modified menu item graphical control.
5. The method as described in claim 1 further comprising:
configuring one or more secondary functions to include in a sub-menu;
modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu;
saving the secondary functions and the modified menu item.
7. The method as described in claim 1 wherein the programmed functions include one or more application programs.
8. The method as described in claim 1 wherein the programmed functions include one or more application functions corresponding to an application program and wherein the menu item graphical control corresponds to the application program.
9. An information handling system comprising:
one or more processors;
a memory accessible by the processors;
a nonvolatile storage area accessible by the processors;
a display screen accessible by the processors;

PATENT

an input device capable of a receiving input from a user corresponding to data displayed on the display screen; and a secondary function menu item tool to include secondary functions with a menu item graphical control, the secondary function menu item tool including:

display logic for displaying a plurality of graphical components with the menu item graphical control on the display device, each of the graphical components corresponding to a different programmed function, wherein the menu item graphical control includes a default area in addition to the plurality of graphical components;

menu item logic for displaying the menu item graphical control with the included graphical components and the default area, wherein each of the graphical components are displayed in a position horizontal to the default area;

input processing logic for receiving a selection from a user corresponding to the menu item graphical control;

task scheduling logic for invoking a default function in response to the selection corresponding to the default area of the menu item graphical control; and

in response to the selection corresponding to one of the graphical components, task scheduling logic for invoking the programmed function corresponding the selected graphical component.

10. The information handling system as described in claim 9 further comprising:

PATENT

display logic for displaying a sub-menu of selectable programmed functions in response to the user selecting a sub-menu graphical component.

11. The information handling system as described in claim 9 wherein at least one of the graphical components includes a graphical icon that is displayed on the menu item graphical control.
12. The information handling system as described in claim 9 further comprising:
configuration logic for configuring the plurality of programmed functions using a configuration tool;
graphic modification logic for modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions; and
storage handling logic for saving the configured plurality of programmed functions and the modified menu item graphical control to the nonvolatile storage area.
13. A computer program product stored on a computer operable medium for providing secondary functions from a menu item graphical control, said computer program product comprising:
means for including a plurality of graphical components with the menu item graphical control, each of the graphical components corresponding to a different programmed function, wherein the menu item graphical control includes a default area in addition to the plurality of graphical components;

PATENT

means for displaying the menu item graphical control with the included graphical components and the default area, wherein each of the graphical components are displayed in a position horizontal to the default area;

means for receiving a selection from a user corresponding to the menu item graphical control;

means for invoking a default function in response to the selection corresponding to the default area of the menu item graphical control; and

in response to the selection corresponding to one of the graphical components, means for invoking the programmed function corresponding the selected graphical component.

14. The computer program product as described in claim 13 further comprising:

means for displaying a sub-menu of selectable programmed functions in response to the user selecting a sub-menu graphical component.

15. The computer program product as described in claim 13 wherein at least one of the graphical components includes a graphical icon that is displayed on the menu item graphical control.

16. The computer program product as described in claim 13 further comprising:

means for configuring the plurality of programmed functions using a configuration tool;

PATENT

means for modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions; and

means for saving the configured plurality of programmed functions and the modified menu item graphical control.

17. The computer program product as described in claim 13 further comprising:

means for configuring a plurality of secondary functions to include in a sub-menu;

means for modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu;

means for saving the plurality of secondary functions and the modified menu item.
19. The computer program product as described in claim 13 wherein the programmed functions include one or more application programs.
20. The computer program product as described in claim 13 wherein the programmed functions include one or more application functions corresponding to an application program and wherein the menu item graphical control corresponds to the application program
21. A method of providing secondary functions from a menu item graphical control, said method comprising:

configuring one or more secondary functions to include in a sub-menu;

PATENT

modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu, wherein the menu item graphical control further includes one or more graphical components corresponding to one or more programmed functions; and

displaying the sub-menu in response to a user selecting the sub-menu graphical component.

22. A method of providing secondary functions from a menu item graphical control, said method comprising:
- configuring a plurality of programmed functions using a configuration tool;
 - identifying a plurality of graphical components for each of the programmed functions;
 - modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions;
 - displaying the menu item graphical control with the included graphical components;
 - receiving a selection from a user corresponding to one of the graphical components; and
 - invoking the programmed function corresponding the selected graphical component.
23. An information handling system comprising:
- one or more processors;
 - a memory accessible by the processors;
 - a nonvolatile storage area accessible by the processors;
 - a display screen accessible by the processors;

PATENT

an input device capable of a receiving input from a user corresponding to data displayed on the display screen; and
a secondary function menu item tool to include secondary functions with a menu item graphical control, the secondary function menu item tool including:

means for configuring one or more secondary functions to include in a sub-menu;

means for modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu, wherein the menu item graphical control further includes one or more graphical components corresponding to one or more programmed functions; and

means for displaying the sub-menu in response to a user selecting the sub-menu graphical component.

24. An information handling system comprising:

one or more processors;

a memory accessible by the processors;

a nonvolatile storage area accessible by the processors;

a display screen accessible by the processors;

an input device capable of a receiving input from a user corresponding to data displayed on the display screen; and

a secondary function menu item tool to include secondary functions with a menu item graphical control, the secondary function menu item tool including:

means for configuring a plurality of programmed functions using a configuration tool;

PATENT

means for identifying a plurality of graphical components for each of the programmed functions;

means for modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions;

means for displaying the menu item graphical control with the included graphical components;

means for receiving a selection from a user corresponding to one of the graphical components; and

means for invoking the programmed function corresponding the selected graphical component.

25. A computer program product stored on a computer operable medium for providing secondary functions from a menu item graphical control, said computer program product comprising:

means for configuring one or more secondary functions to include in a sub-menu;

means for modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu, wherein the menu item graphical control further includes one or more graphical components corresponding to one or more programmed functions; and

means for displaying the sub-menu in response to a user selecting the sub-menu graphical component.

26. A computer program product stored on a computer operable medium for providing secondary functions from a menu item graphical control, said computer program product comprising:

PATENT

J. APPENDIX - EVIDENCE

The attached declaration under 37 C.F.R. § 1.131 was submitted with the Response to the Final Rejection filed by Appellant on October 28, 2004. It was entered by the Examiner as shown in the attached Advisory Action dated November 23, 2004.